

REMARKS

Double Patenting Rejections

Rejection over Moline et al. and Rothe et al.

Claims 1-3, 5-6, 10-20, 22, and 35-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-101 of Moline et al. (U.S. Patent Application No. 10/289,557) in view of Rothe et al. (U.S. Patent No. 4,738,847).

The rejection of claims 1-3, 5-6, 10-20, 22, and 35-47 under the judicially created doctrine of obviousness-type double patenting is obviated by the filing of an appropriate terminal disclaimer. Pursuant to 37 CFR 1.130(b), a terminal disclaimer pursuant to 37 CFR 1.321(c) with respect to U.S. Patent Application No. 10,289,557 is filed herewith. The present application and U.S. Patent Application No. 10,289,557 are commonly owned by Kimberly-Clark Worldwide, Inc. Applicants request that this rejection be withdrawn.

Rejection over Moline et al., Rothe et al., and Roe et al.

Claim 4 was rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-30 of Moline et al. (U.S. Patent Application No. 10/289,557) in view of Rothe et al.

The rejection of claims 1-3, 5-6, 10-20, 22, and 35-47 under the judicially created doctrine of obviousness-type double patenting is obviated by the filing of an appropriate terminal disclaimer. Pursuant to 37 CFR 1.130(b), a terminal disclaimer pursuant to 37 CFR 1.321(c) with respect to U.S. Patent Application No. 10,289,557 is filed herewith. The present application and U.S. Patent Application No. 10,289,557 are commonly owned by Kimberly-Clark Worldwide, Inc. Applicants request that this rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Rejection over Rothe et al. and Walter et al.

Claims 35-41 and 46 stand rejected under 35 U.S.C. § 103 in view of Rothe et al. and Walter et al. (U.S. Patent No. 4,950,545 or 5,227,242). Applicants respectfully traverse this rejection. Neither Rothe nor Walter, alone or in combination, provides the necessary motivation to combine the references.

The Examiner asserts that motivation to combine the above references is found in the desire to impart softness to the absorbent multi-ply tissue article. (Office Action dated August 24, 2005, p. 5). The Examiner is actually attempting to impart the inappropriate “obvious to try” rationale. However, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). Obviousness requires one of ordinary skill in the art have a reasonable expectation of success as to the invention—“**obvious to try**” and “absolute predictability” are incorrect standards. *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)(emphasis added). The presence of a reasonable expectation of success is measured from the perspective of a person of ordinary skill in the art at the time the invention was made. *Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1326 (Fed. Cir. 2000). To this end, the ultimate success of the invention is irrelevant. *Id.*

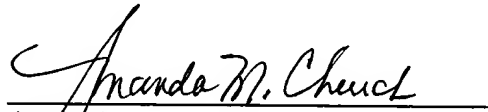
One of skill in the art would not have been motivated to combine the references cited because there would have been no reasonable expectation of success. When silicone is added to the top layer of a multi-layered tissue material, for example, it may be expected that the silicone will migrate through the layers of the material, especially when it is wound into a roll. The migration of the silicone may interact with other ingredients held within the other layers of the tissue. Therefore, while various references, if combined, may disclose the elements of the claimed invention, no combination of references would provide the motivation or suggestion necessary to render the claimed invention obvious. Reading the references of the prior art, one of skill in the art would not have had a reasonable expectation of success of combining the

cited references. Therefore, a *prima facie* case of obviousness has not been presented. Applicants respectfully request this rejection be withdrawn.

SUMMARY

All grounds raised in the outstanding Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks above. Thus, it is respectfully requested that all of the presently presented claims are in form for allowance, and such action is requested in due course. Should the Examiner feel a discussion would expedite the prosecution of this application; the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,

A handwritten signature in cursive script that reads "Amanda M. Church". The signature is written in black ink and is positioned above a horizontal line.

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